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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/837,739	04/06/2001	Jim Reich	540606-2001	9745

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FROMMER LAWRENCE & HAUG
745 FIFTH AVENUE- 10TH FL.
NEW YORK, NY 10151

EXAMINER

BOYD, JENNIFER A

ART UNIT	PAPER NUMBER
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1771

DATE MAILED: 05/26/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/837,739

Applicant(s)

REICH, JIM

Examiner

Jennifer A. Boyd

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 March 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 15-17, 19-21 and 23-28 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 15-17, 19-21 and 23-28 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 3/28/05 has been entered. The Applicant's Amendments and Accompanying Remarks, filed 3/28/05, have been entered and have been carefully considered. Claims 25 – 28 are added and claims 15 – 17, 19 – 21 and 23 – 28 are pending. The invention as currently claimed is not found to be patentable for reasons herein below.

2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 25 – 28 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

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5. Claims 25 – 28 require that the fabric of the invention reduces odors by about 33% or more when compared to a regular fabric. The Examiner is unable to determine the scope of the claims. What constitutes a “regular fabric” and what is the level of odor absorption exhibited by the “regular fabric”? For the purposes of examination at this time, the Examiner will assume that any fabric meeting the physical and chemical characteristics as claimed would exhibit Applicant’s odor reduction by about 33% or more capability.

Claim Rejections - 35 USC § 103

6. Claims 15 – 16, 19, 23 and 25 - 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Clarke (US 6,258,455).

Clarke is directed to an antimicrobial ultra-microfiber cloth (Title).

As to claims 15, 23 and 27 - 28, Clarke teaches a material produced by combining ultra-microfiber yarns with yarns of antimicrobial fiber such as an acetate fiber sold under the name MICROSAFE (column 3, lines 1 – 15). Clarke teaches that the yarn may additionally comprise polyester to increase the strength of the yarn (column 3, lines 15 – 20). Clarke teaches that the material can woven or knitted (column 1, lines 5 – 10).

As to claim 16, Clarke teaches that MICROSAFE fibers can be used as the anti-microbial fiber (column 4, lines 15 – 30), which is known in the art to contain triclosan.

As to claim 19, Clarke teaches that the antimicrobial fibers and ultra-microfibers can be intermixed by air jet texturing (column 3, lines 60 – 67).

As to claims 15, 23 and 27 - 28, Clarke discloses the claimed invention except for that the antimicrobial acetate fiber is present in the amount of at least 25% by weight of the fabric. It should be noted that the amount of antimicrobial acetate fiber in the fabric is a result effective variable. Clarke teaches that it is preferable that approximately 18% of the total material comprises acetate antimicrobial fiber (column 4, lines 8 – 12). However, Clarke notes that higher and lower concentrations of antimicrobial fiber may be acceptable in particular circumstances (column 4, lines 16 – 19). For example, as the level of antimicrobial acetate increases, the fabric becomes more effective in destroying bacteria. It would have been obvious to one having ordinary skill in the art at the time the invention was made to create a material with antimicrobial acetate fiber present in the amount of 25% of the total weight of the fabric since it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art. *In re Boesch*, 617 F.2d 272, 205 USPQ 215 (CCPA 1980). In the present invention, one would have been motivated to optimize the percentage of antimicrobial acetate based on the desired application of the material.

As to claims 25 – 28, although Clarke does not explicitly teach the claimed fabric reduces odors by about 33% or more when compared to a regular fabric, it is reasonable to presume that the fabric's ability to reduce odors by about 33% or less is inherent. Support for said presumption is found in the use of like materials (i.e. a woven or knitted fabric comprising air jet textured yarns comprising polyester and MICROSAFE acetate fibers, where the MICROSAFE fibers are present in the amount of at least 5% by weight) which would result in the claimed property. The burden is upon the Applicant to prove otherwise. *In re Fitzgerald* 205 USPQ 594. In addition, the presently claimed property of reduced odor by about 33% or more would

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obviously have been present once the Clarke product is provided. Note *In re Best*, 195 USPQ at 433, footnote 4 (CCPA 1977).

7. Claims 20 – 21 and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Clarke (US 6,258,455) in view of Newman (US 6,000,057).

Clarke teaches the claimed invention above except fails to teach that the fabric is an odor-reducing fabric for use in an odor-reducing hunting garment.

Newman is directed to odor preventing hunting apparel (Title). Newman teaches a fabric for use in the construction of hunting clothing, preferably undergarments such as T-shirts, briefs, socks, thermal underwear, gloves, hats, scarves etc. having directed and intimate contact with the skin (column 1, lines 50 – 55). Newman teaches that the clothing is effective for preventing the growth and reproducing of odor-producing bacteria on the body, and thereby reducing body odor, by simply wearing the antimicrobial clothing (column 2, lines 1 – 5). Newman teaches that antimicrobial fabric such as those available from Microban Products Company under the MICROBAN mark, such as MICROSAFE fabric is suitable for the inner layer of fabric in the piece of clothing (column 1, lines 55 – 60).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to use the material of Clarke as the inner layer of fabric in the odor preventing hunting apparel of Newman motivated by the desire to use an anti-microbial fabric with MICROSAFE fibers as desired by Newman which is high strength due to the integration of polyester fibers to create a durable garment.

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8. Claims 15 – 17, 19, 23 and 25 – 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gurian (US 5,856,005).

Gurian is directed to a permanently anti-microbial and flame-retardant yarn and fabric made therefrom (Title).

As to claims 15, 23 and 27 - 28, Gurian teaches a yarn with base filaments formed of a plurality of the permanently flame-retardant filaments and a pair of effect filaments – one of the plurality of permanently flame-retardant filaments and one of the plurality of permanently anti-microbial filaments (column 3, lines 23 – 45). Gurian teaches that the permanently flame-retardant filaments are made of polyester and available under the trade name TREVIRA (column 4, lines 30 – 38). Gurian teaches that the permanently anti-microbial filaments are formed of cellulose acetate permanently impregnated with up to 2% by weight of chlorinated phenoxy compound available under the trade name MICROBAN B as an anti-microbial agent (column 4, lines 15 – 30). It should be noted that the preferred anti-microbial filaments are available under the trade name MICROSAFE acetate (column 4, lines 20 – 25). Gurian teaches that the yarn can be incorporated into a knitted or woven fabric (column 4, lines 53 – 60). Gurian teaches that the fabric comprises at least 5% by weight of the anti-microbial filaments (column 4, lines 60 – 65). It should be noted that Gurian does not define an upper limit.

As to claim 16, Gurian teaches that MICROBAN can be used as the anti-microbial agent (column 4, lines 15 – 30), which is known in the art to be a form of triclosan.

As to claim 17, Gurian teaches the use of Hoechst-Celanese T692 SD (semi-dull) polyester (column 5, lines 40 – 45).

As to claim 19, Gurian teaches that the permanently flame-retardant filaments and permanently anti-microbial filaments air jet textured to create yarns (column 4, lines 45 – 50).

As to claims 15, 23 and 27 – 28, Gurian discloses the claimed invention except for that the fabric comprises at least 25% anti-microbial acetate filaments by weight of the fabric. It should be noted that the amount of antimicrobial acetate filaments is a result effective variable. For example, as the amount of antimicrobial fibers increase, the fabric exhibits more anti-microbial characteristics. It would have been obvious to one having ordinary skill in the art at the time the invention was made to create a fabric comprising at least 25% by weight of anti-microbial acetate filaments, since it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art. *In re Boesch*, 617 F.2d 272, 205 USPQ 215 (CCPA 1980). In the present invention, one would have been motivated to optimize the amount of anti-microbial filaments to create a fabric having suitable anti-microbial properties.

As to claims 25 – 28, although Gurian does not explicitly teach the claimed fabric reduces odors by about 33% or more when compared to a regular fabric, it is reasonable to presume that the fabric's ability to reduce odors by about 33% or less is inherent. Support for said presumption is found in the use of like materials (i.e. a woven or knitted fabric comprising air jet textured yarns comprising polyester and MICROSAFE acetate fibers, where the MICROSAFE fibers are present in the amount of at least 5% by weight) which would result in the claimed property. The burden is upon the Applicant to prove otherwise. *In re Fitzgerald* 205 USPQ 594. In addition, the presently claimed property of reduced odor by about 33% or more

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would obviously have been present once the Gurian product is provided. Note *In re Best*, 195 USPQ at 433, footnote 4 (CCPA 1977).

9. Claims 20 – 21 and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gurian (US 5,856,005) in view of Newman (US 6,000,057).

Gurian teaches the claimed invention above except fails to teach that the fabric is an odor- reducing fabric for use in an odor-reducing hunting garment.

Newman is directed to odor preventing hunting apparel (Title). Newman teaches a fabric for use in the construction of hunting clothing, preferably undergarments such as T-shirts, briefs, socks, thermal underwear, gloves, hats, scarves etc. having directed and intimate contact with the skin (column 1, lines 50 – 55). Newman teaches that the clothing is effective for preventing the growth and reproducing of odor-producing bacteria on the body, and thereby reducing body odor, by simply wearing the antimicrobial clothing (column 2, lines 1 – 5). Newman teaches that antimicrobial fabric such as those available from Microban Products Company under the MICROBAN mark, such as MICROSAFE fabric is suitable for the inner layer of fabric in the piece of clothing (column 1, lines 55 – 60).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to use the material of Gurian as the inner layer of fabric in the odor preventing hunting apparel of Newman motivated by the desire to use an anti-microbial fabric with MICROSAFE fibers as desired by Newman which is high strength due to the integration of polyester fibers to create a durable garment.

Response to Arguments

10. Applicant's arguments filed June 28, 2004 have been fully considered but they are not persuasive.

11. In response to Applicant's argument that Gurian fails to disclose that the fabric can be an odor-reducing fabric, the Examiner admits Gurian does not specifically disclose such a function for the fabric. A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). It should be noted that Gurian meets all claimed structural and/or chemical limitations. Gurian discloses a woven or knitted fabric comprising polyester and acetate comprising MICROBAN, wherein the acetate fiber is present at least 5 % by weight of the fabric, and the polyester and acetate fibers are entwined by means of air entanglement. Since Gurian meets all claimed structural and/or chemical limitations and there is nothing on record to support the contrary, it is asserted that the "odor-reducing" property must be inherent to the Gurian product. If said "odor reducing" property is not inherent, it is asserted that Applicant's claim must be incomplete. In other words, if Applicant's asserts a lack of inherency in the Gurian product, then Applicant's claimed invention is missing an element that is critical to the invention, which would patentably distinguish it from the known prior art.

12. In response to Applicant's argument that an increase in the percent by weight of the acetate in the fabric of Gurian, i.e., up to 25% by weight, would likely lead to the loss of flame-retardant properties of the fabric and render the invention of Gurian inoperable, the Examiner

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cannot question the validity of the disclosure of the patent. The Examiner agrees that Gurian discloses examples where a fabric is comprised of 94% polyester and 6% acetate and another fabric is comprised of 91% flame-retardant polyester and 9% acetate. Although the examples only suggest using 6% in one example and 9% in another example, they should be only treated as examples. It should be noted that disclosed examples and preferred embodiments do not constitute a teaching away from a broader disclosure or nonpreferred embodiments. *In re Susi*, 440 F.2d 442, 169 USPQ 423 (CCPA 1971). It would be improper to ignore the complete disclosure of the patent. It should be noted that Gurian discloses the use of at least 5% by weight and provides **no upper limit** for the weight percentage of anti-microbial filaments in the fabric (column 4, lines 53 – 65). The Exhibits have been reviewed by the Examiner. The Examiner submits that the Exhibits are irrelevant because the disclosure of the Gurian patent specifically states the use of at least 5% by weight. Although DesignTex might not sell flame-resistant and anti-microbial fabric having a content more than 11%, it does not suggest that the patent to DesignTex did not intend to claim at least 5% by weight with no upper bound.

13. The Applicant argues that Gurian's fabric would not provide significant odor reduction as required by the present invention. The Applicant does not provide evidence in support of this argument. Furthermore, as discussed above, Gurian discloses the use of at least 5% by weight and provides **no upper limit** for the weight percentage of anti-microbial filaments in the fabric (column 4, lines 53 – 65). Therefore, the amount of antimicrobial acetate present in Gurian would overlap Applicant's required range and it would be obvious to optimize the amount of antimicrobial acetate specifically to greater than 25% to adjust the level of antimicrobial properties.

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14. In response to Applicant's argument that Clarke is directed towards the use of microfibers while the present invention does not utilize microfibers, the Examiner respectfully argues that the fiber size is irrelevant. The Examiner acknowledges that microfibers are quite different in size and also characteristics when compared to fibers of a larger size. However, the Applicant does not claim a certain fiber size in the claims. Therefore, the cloth containing microfibers of Clarke would read on the claim as currently drafted because it meets all **claimed** limitations. If the Applicant requires that the fabric of the present invention cannot contain microfibers or the fabric requires high strength fibers, the Applicant should put limitations in the claims to requiring a certain denier size or requiring that the fibers cannot be microfibers.

15. In response to applicant's argument that Clarke and Newman are nonanalogous art and, therefore, there would be no suggestion to combine the references, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, Clarke is directed to an antimicrobial cloth that is suitable for a variety of applications includes mops, dishcloths, towels, wiping clothes, diapers, sanitary napkins and other feminine hygiene products, bed sheets, pillow cases and the like (Title and column 4, lines 63 – 68). Newman is directed to an odor-preventing hunting apparel comprising an antimicrobial fabric (Abstract). Clarke is suitable for a variety of applications and comprises antimicrobial fibers, therefore, it would be obvious and suggested that it could be used in an application such as Newman.


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16. Applicant's argues that the fabric of the present invention is more successful at reducing odor than the ContainTM used in Newman and will be submitting a Declaration by the inventor that describes comparative tests between the fabric of the present invention, traditional fabric and that of the ContainTM line. The Declaration has not been received rendering Applicant's comments moot.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jennifer A. Boyd whose telephone number is 571-272-1473. The examiner can normally be reached on Monday thru Friday (8:30am - 6:00pm).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris can be reached on 571-272-1478. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Jennifer Boyd
May 17, 2005


Ula C. Ruddock
Primary Examiner
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